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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/118,824 07/20/98 LEE

J

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EXAMINER

TRAN, T

ART UNIT

PAPER NUMBER

2615

DATE MAILED:

09/04/01

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/118,824

Applicant(s)

LEE ET AL.

Examiner

Thai Tran

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31, 33-50 and 52-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 is/are allowed.
- 6) ☒ Claim(s) 23-31, 33-50 and 52-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/227,281.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Reissue Applications***

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed.

See 37 CFR 1.178.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 23-31, 33-51 and 52-61 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 23-24, 26-28, 30-31, 33-37, 39, 42-43, 45-47, 49-50, 52-56 and 59-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Fujinami et al ('585).

Regarding claim 23, Fujinami et al discloses an apparatus for controlling recording in a digital recording device (Fig. 11) having an input unit receiving digital video data (video encoder 1 of Fig. 11, col. 10, lines 42-59); a data generating circuit (switching circuit 6 of Fig. 11, col. 10, lines 42-59 and col. 12, lines 10-33) generating a plurality of relative position data, each of the plurality of relative position data

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associated with one of a plurality of specific data in the received digital video data and indicative of a plurality of relative positions from a current  $n$ th specific data location to each of  $n+1$ ,  $n+2$ , ...  $n+m$  specific data location, where  $m$  is greater than 2; and a recording unit (digital storage medium (DSM) 10 of Fig. 11, col. 1, lines 26-40 and col. 12, lines 10-34).

Regarding claim 24, Fujinami et al also discloses the claimed wherein the specific data further includes I-frame data (col. 14, lines 54-67).

Regarding claim 26, Fujinami et al discloses the claimed wherein the digital medium includes a magnetic medium (col. 1, lines 26-40).

Regarding claim 27, Fujinami et al further discloses the claimed wherein each of the plurality of relative position data includes a plurality of distance indicators, each distance indicator indicating a distance between the current  $n$ th specific data location and one of the  $n+1$ ,  $n+2$ , ...  $n+m$  specific data locations (col. 11, lines 53-63 and col. 15, lines 1-7).

Regarding claim 28, Fujinami et al further discloses the claimed wherein said distance is represented with a number of distance units present between the current  $n$ th specific data location and one of the  $n+1$ ,  $n+2$ , ...,  $n+m$  specific data locations (col. 11, lines 53-63 and col. 15, lines 1-7).

Regarding claim 30, Fujinami et al additionally disclose the claimed a formatting circuit (element 7 of Fig. 11, col. 11, lines 19-63 and col. 14, lines 54-67) forming a data block associated with each specific data, the data block including the associated relative position data.

Regarding claim 31, Fujinami et al also discloses wherein the specific data further includes I-frame data (col. 14, lines 54-67).

Regarding claim 33, Fujinami et al discloses an apparatus (Fig. 12) for controlling reproduction in a digital reproducing device having a reproducing unit (DSM 10 of Fig. 12, col. 14, lines 36-53) reproducing digital data stored on a digital medium, the digital data including a plurality of specific data, each of said plurality of specific data including relative position data, each relative position data indicative of a plurality of relative positions from a current  $n$ th specific data location to each of a  $n+1$ ,  $n+2$ , ...,  $n+m$  specific data location, where  $m$  is greater than 2; a detection circuit (the control circuit 24 of Fig. 12, col. 14, lines 36-53) coupled to the reproducing unit and detecting one of the plurality of relative position data from the reproduced digital data; and a control circuit (the control circuit 24 of Fig. 12, col. 14, lines 36-45) coupled to the detection circuit, receiving a command and controlling the reproducing unit to reproduce at least another specific data based on the detected relative position data and the command.

Regarding claim 34, Fujinami et al discloses the claimed wherein the detection circuit includes a decoding circuit (col. 14, lines 36-67) selecting one of the relative positions represented in said detected relative position data based on the command.

Regarding claim 35, Fujinami et al further discloses wherein the specific data further includes I-frame data (col. 14, lines 54-67).

Regarding claim 36, Fujinami et al further discloses the claimed wherein each of the plurality of relative position data includes a plurality of distance indicators, each distance indicator indicating a distance between the current  $n$ th specific data location

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and one of the  $n+1$ ,  $n+2$ , ...,  $n+m$  specific data locations (col. 11, lines 53-63 and col. 15, lines 1-7).

Regarding claim 37, Fujinami et al further discloses the claimed wherein said distance is represented with a number of distance units present between the current  $n$ th specific data location and one of the  $n+1$ ,  $n+2$ , ...,  $n+m$  specific data locations (col. 11, lines 53-63 and col. 15, lines 1-7).

Regarding claim 39, Fujinami et al additionally discloses the claimed wherein the reproducing unit includes a motor for moving the digital medium (col. 1, lines 26-40).

The method claims 42-43, 45-47 and 49-50 are rejected for the same reasons as discussed in the apparatus claims 23-24, 26-28 and 30-31 above.

The method claims 52-56 are rejected for the same reasons as discussed in the apparatus claims 33-37.

Regarding claim 59, Fujinami et al discloses the claimed a detection circuit (video entry point detection circuit 31 of Fig. 11, col. 10, lines 42-59) and wherein the data generating circuit is coupled to the detection circuit (col. 10, lines 42-59).

The claims recording medium 60-61 are rejected for the same reasons as discussed in the apparatus claims 23-24 above.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 25, 29, 38, 44, 48 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujinami et al ('585) in view of Naimpally ('993 and of record).

Regarding claim 25, Fujinami et al discloses all the features of the instant invention except for providing a timing signal generating circuit for generating a timing control signal and a multiplexer coupled to the timing signal generating circuit and selectively outputting the detected specific data and the digital video data based on the timing control signal.

Naimpally teaches a digital high definition television video recorder with trick-play features having a timing signal generating circuit (328 of Fig. 3) generating a timing control signal and a multiplexer (318 of Fig. 3) coupled to the timing signal generating circuit and selectively outputting the signals to be recorded based on the timing control signal.

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Fujinami et al's system with the timing signal generating

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circuit and the multiplexer as taught by Naimpally since it merely amounts to selecting an alternative equivalent recording method or increase the life time of the apparatus because VTR last longer than disc player.

Regarding claim 29, when Fujinami et al and Naimpally are combined, the entry packet would indicate a track on the storage medium.

Claim 38 is rejected for the same reasons as discussed in claim 29 above.

Claim 44 is rejected for the same reasons as discussed in claim 25 above.

Claim 48 is rejected for the same reasons as discussed in claim 29 above.

Claim 57 is rejected for the same reasons as discussed in claim 29 above.

6. Claims 40-41 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujinami et al ('585) in view of Office Notice.

Regarding claim 40, Fujinami et al discloses all the features of the instant invention except for providing a calculating circuit for calculating a rotational speed of the motor based on the detected relative position data.

The capability of controlling the rotating of the recording disk by using a calculating circuit calculating a rotational speed of the motor is well known in the art and therefore Official Notice.

It would have been obvious to one of ordinary skill in the art at the time of the invention to control the rotating of the recording disk by using the well known calculating circuit in order to accurately record/reproduce video signal by controlling the rotating of the recording.



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Regarding claim 41, Fujinami et al discloses all the features of the instant invention except for providing the claimed wherein the reproducing unit includes reading heads.

The capability of reproducing data recorded on the recording medium by using reading heads is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the well known reproducing unit having reading heads for the reproducing unit of Fujinami et al's system in order to increase the reproducing speed when reproducing data from the recording medium.

Claim 58 is rejected for the same reasons as discussed in claim 40 above.

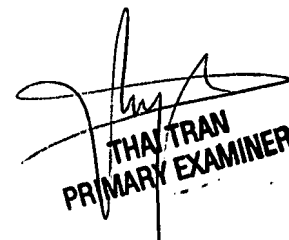
***Allowable Subject Matter***

7. Claims 1-22 are allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
THAI TRAN  
PRIMARY EXAMINER